

## **REMARKS**

In the specification, the Abstract is amended and paragraph [0008] is deleted.

Claims 1 and 3-32 remain in this application. Claims 1, 3, 4, 6, 7, 11, 12 and 14-32 are currently amended. Claim 2 is canceled. No claims have been or are withdrawn.

### **I. SPECIFICATION**

The examiner objected to the disclosure because the Abstract exceeded 150 words in length. The examiner also objected to the disclosure because of an improper reference to a claim in paragraph [0008].

The applicant amends the Abstract above and respectfully submits that the amended Abstract overcomes the examiner's objection. The applicant deletes paragraph [0008].

### **II. CLAIM OBJECTIONS**

The examiner objected to claims 1 and 11 stating that the word "the" before "said" should be deleted. The examiner objected to claim 20 stating that the word "chive" in claim 20 should be deleted.

The applicant amends claims 1 and 11 by removing all occurrences of the word "the" before the word "said". The applicant amends claim 20 by changing the word "chive" to "drive". The applicant respectfully submits that the amendments to the claims overcomes the examiner's objection and requests that the examiner remove the objection.

### **III. CLAIM REJECTIONS – 35 USC § 112**

#### **A. Examiner's Statements**

The examiner rejected claims 1-32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Specifically, the examiner stated that in claims 1 and 27, the phrase "or similar" renders the claim indefinite. The examiner also stated that, regarding claims 1, 6, 7, 12, 15, 16, 24, and 31, the term "in particular" renders the claims indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. The examiner also stated that claims 1, 3-5, 7-13, 15-17, and 19-32 have limitations that lack antecedent basis.

#### **B. Law**

A claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.<sup>1</sup> In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim

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<sup>1</sup> *In re Swinehart*, 439 F.2d 210, 160 U.S.P.Q. 226 (CCPA 1971)

apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.<sup>2</sup> Breadth of a claim is not to be equated with indefiniteness.<sup>3</sup> If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute [35 U.S.C. §112, second paragraph] demands no more.<sup>4</sup>

### **C. Claims**

The applicant currently amends claims 1 and 27 by removing the phrase “or similar”. The applicant amends claims 1, 6, 7, 12, 15, 16, 24, and 31, to remove the term “in particular”. The applicant also amends claims 1, 15, 16, 25, 29-31 to correct have limitations that lack antecedent basis.

## **IV. CLAIM REJECTIONS – 35 USC § 102**

### **A. Examiner’s Statements**

The examiner rejected claims 1-3, 5-13, 17, and 25-30, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Biester, et al. (WO 02/37008).

### **B. Law**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>5</sup> The identical invention must be shown in as complete detail as is contained in the ... claim.<sup>6</sup> In addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention.<sup>7</sup>

### **C. Claims 1-3, 5-13, 17, and 25-30**

The applicant respectfully submits that claims 1-3, 5-13, 17, and 25-30 of the present application are not anticipated by Biester et al. because Biester et al. does not disclose all of the recited

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<sup>2</sup> See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000).

<sup>3</sup> *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971).

<sup>4</sup> *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986).

<sup>5</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

<sup>6</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

<sup>7</sup> *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

claim limitations. Claims 1-3, 5-13, 17, and 25-30 recite a device housing and a spindle drive within the device housing. The spindle drive includes a rotating spindle and a nut surrounding and moveable in the longitudinal direction along the rotating spindle upon rotation of the spindle. The nut includes at least one engaging element protruding radially from the nut that is in traveling engagement with both a fixed collar guide slot and a rotating collar guide slot. Rotation of the nut is prevented by the engagement of the at least one engaging element in the fixed collar guide slot. The rotating sleeve is rotatable by the travel of the engaging element in the longitudinal direction through the rotating sleeve guide slot.

Biester et al., however, teaches an actuator device 25 that comprises at least one electro motor 43. The motor 43 turns a ball nut 46, which drives a ball screw 44. The ball nut 46 can rotate, but is mounted in the actuator device 25 so that it cannot move axially. Turning the ball nut 46 causes a recirculating ball spindle 45 of the ball screw 44 to be repositioned in the longitudinal direction of the actuator device 25. An operating element 24 which is connected to the recirculating ball spindle 45 is repositioned accordingly, and thus likewise a feed element 22 of the rotary adjusting device 1. However, the spindle 45 only moves longitudinally and does not actually rotate.

As the feed element 22 is shifted longitudinally, the pin 17 moves within a guide slots 11, 12 in the rotary sleeve 4 as well as guide slots 13, 14 in the bearing sleeve 5. The guide slots 11, 12 of the rotary sleeve are at a different angle relative to the guide slots 13, 14 of the bearing sleeve 5, which are in a straight line. Because the bearing sleeve 5 does not rotate but the rotary sleeve 4 does, the longitudinal travel of the pin 17 through the guide slots 11, 12, 13, 14 causes the rotary sleeve 4 to rotate.

Thus, Biester et al. never discloses a spindle that actually rotates. Therefore, Biester et al. does not disclose a rotating spindle and a nut surrounding and moveable in the longitudinal direction along the rotating spindle upon rotation of the spindle as required by claims 1-3, 5-13, 17, and 25-30. Instead, Biester et al. teaches that the spindle is adjusted longitudinally without rotating by a rotating ball nut 46. The applicant therefore respectfully submits that the rejection is unsupported by the art and requests that the examiner withdraw the rejection.

## **V. CLAIM REJECTIONS - 35 U.S.C. § 103**

### **A. Examiner's Statements**

The examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Biester et al. The examiner also rejected claims 14-16, 22, 31, and 32 under 35 U.S.C. §103(a) as being

unpatentable over the combination of Biester et al. and Gilges et al. (U.S. Patent No. 5,370,011). The examiner also rejected claims 18-21, 23, and 24 under 35 U.S.C. §103(a) as being unpatentable over the combination of Biester et al. and Appleford et al. (U.S. Patent No. 5,497,672).

#### **B. Law**

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>8</sup> If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

#### **C. Claim 4**

Claim 4 depends directly from allowable claim 1. The applicant repeats and hereby incorporates the remarks made above regarding allowable claim 1. For at least these reasons, the applicant respectfully submits that claim 4 is also allowable.

#### **D. Claims 14-16, 22, 31, and 32**

Claims 14-16, 22, 31, and 32 depend either directly or indirectly from allowable claim 1. The applicant repeats and hereby incorporates the remarks made above regarding allowable claim 1. For at least these reasons, the applicant respectfully submits that claims 14-16, 22, 31, and 32 are also allowable.

#### **E. Claims 18-21, 23, and 24**

Claims 18-21, 23, and 24 depend indirectly from allowable claim 1. The applicant repeats and hereby incorporates the remarks made above regarding allowable claim 1. For at least these reasons, the applicant respectfully submits that claims 18-21, 23, and 24 are also allowable.

### **VI. AMENDMENTS MADE NOT RELATED TO PATENTABILITY**

The applicant has amended the claims to more clearly, correctly, and properly claim the invention and not necessarily for purposes of patentability.

These statements are not an admission that any other particular amendment was made for purposes of patentability, meant to be limiting in any way, or meant to be all-inclusive of amendments not made for purposes of patentability.

### **VII. STATEMENT REGARDING CLAIMS**

The applicant comments on the allowability of the claims by addressing the examiner's comments in this paper as well as previously during the prosecution of this application. By doing so,

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<sup>8</sup> *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

the applicant is in no way limiting its ability to identify additional points of novelty regarding the independent claims or dependent claims at a later date.

### CONCLUSION

The applicant respectfully requests reconsideration the non-allowed claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, the examiner is invited to contact the undersigned.

In the course of the foregoing discussions, the applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicant may have amended certain claims, the applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed in a continuing application.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1600-11700) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,  
CONLEY ROSE, P.C.

/Collin A. Rose/

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